

## REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

### Election/Restrictions

**1** Newly submitted claim 20 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 20 is directed towards the same subject matter as claim 36 that was withdrawn due to being in a non elected Invention.

**2** Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 20 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Without conceding the examiner's position, claim 20 has been amended to depend on claim 1.

### 101 Rejections

**4.** Claims 1-8, 10-19, 21-23, 25-35, 140 and 141 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**5.** Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63,70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent- eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test. Here claims 1-8, 10-19, 21-23, 25-35, 140 and 141 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

The claims have been amended.

### 112 Rejections

**7.** Claims 1-8, 10-19, 21-23 and 25-35 are rejected under 35 U.S.C. 112, first paragraph, failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Claim 1 recites "but not to obtain private information about the account holder without permission of the financial institution that maintains the financial account."

9. Claim 19 recites "a transaction processing party."

10. Claim 21 recites "a financial institution that is independent of the transaction processing party."

11. Claim 21 recites "while excluding all parties except the financial institution in which the financial account is maintained."

12. These limitations are not disclosed in the Specification of the instant application. Therefore, the new limitations are considered New Matter.

The claims have been amended. With respect to the revised language of the claims, the applicant refers the examiner to page 5, lines 11-14; page 1, lines 6-8; page 5, lines 8-9; page 70, lines 8-10; and page 9, line 16, to page 10, line 9.

14. Claims 21-23, 25-35 and 140-141 are rejected under 35 U.S.C. 1 12, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 21 recites "they" in the last sentence.

16. Claim 140 recites "ones" in the sixth sentence.

17. It is unclear who "they" and "ones" is referring to.

The claims have been amended.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Applicant : Bruce Nappi  
Serial No. : 10/669,929  
Filed : September 24, 2003  
Page : 19 of 19

Attorney's Docket No.: 13801-0002001

The applicant requests the examiner completely initial and return Form 1449 filed with an Information Disclosure Statement on February 14, 2008.

Please apply any charges or credits to deposit account 06-1050, reference 13801-0002001.

Respectfully submitted,

Date: \_\_\_\_\_

11/16/9



David L. Feigenbaum  
Reg. No. 30,378

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (877) 769-7945